REMARKS

Claims 1, 4, and 5 are pending.

As a preliminary matter, in the Response to Arguments section, the Office Action states that the Declaration will need to be refiled because it is listed as an amendment.

A Declaration in compliance with 37 C.F.R. § 1.132 is being filed concurrently with this Response.

Claims 1, 4, and 5 are rejected under 35 U.S.C. § 102 for lack of novelty, or alternatively, under 35 U.S.C. § 103 for obviousness over Harris et al. (U.S. 5,424,261). Claims 1, 4, and 5 are rejected under 35 U.S.C. § 102 for lack of novelty, or alternatively, under 35 U.S.C. § 103 for obviousness over Sugiura et al. (U.S. 5,165,983 – hereinafter Sugiura). Claims 1, 4, and 5 are rejected under 35 U.S.C. § 102 for lack of novelty, or alternatively, under 35 U.S.C. § 103 for obviousness over Japanese Document 08157265. Claims 1, 4, and 5 are rejected under 35 U.S.C. § 102 for lack of novelty, or alternatively, under 35 U.S.C. § 103 for obviousness over Japanese Document 5-229873. Claims 1, 4, and 5 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent Nos. 4,920,640 (hereinafter Enloe '640) and 5,017,434 (hereinafter Enloe '434), each taken alone.

The Office Action asserts that the comparative example in the Declaration is not considered to be representative of the teachings of the prior art references for the following reasons. The Office Action states that none of the references applied in the rejections use a glassy carbon setter, which is used in the comparative example. The Examiner avers that Sugiura, JP 08157265, JP 5-229873 and Enloe use BN materials like the instant invention. The Office Action further asserts that the Applicants have not shown that the warpage in the bodies

taught by Sugiura is greater than that claimed. The Office Action states that heating at 1700-1800°C for 2 hours is not equivalent to heating to 850°C as required in the claims.

The temperature of 1850°C found in Table 1a of the Declaration clearly describes the sintering temperature. According to the claimed subject matter per claim 1, the sintering step is *before* a heat treatment step of 850°C for one hour. As discussed in Paragraph 5 of the Declaration, the samples were heat-treated at 850°C for an hour in a non-oxidative atmosphere according to an embodiment of the claimed subject matter. An aspect of the present application includes the sintering step, which **precedes** the heat-treatment step (*see, e.g.,* Fig. 1 and pg. 16, lines 2-15 and pg. 17, lines 3-5 of the originally filed specification). None of the cited references disclose or suggest a single heat treatment at 850°C after sintering, as required in claim 1.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities," *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that the cited references do not anticipate claim 1, nor any claim dependent thereon. The dependent claims are allowable for at least the same reasons as claim 1.

Based upon the arguments submitted *supra*, it should be apparent that a *prima facie* basis to deny patentability to the claimed invention has not been established for want of the requisite factual basis. Moreover, there are potent indicia of nonobviousness of record to support the patentability of the present claimed subject matter. Indeed, the advantageous effect of the present invention in the smooth surface of the setter suppresses the distortion of the formed body

during sintering, is unknown to the prior art of record. Accordingly, the rejection of claims 1, 4, and 5 should be withdrawn.

Claims 1, 4, and 5 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1, 4, and 5 of U.S. Patent Serial No. 11/907,020.

Applicants respectfully request that the Examiner hold this rejection in abeyance until allowable subject matter is obtained in the present application.

Conclusion

In view of the foregoing remarks and the Declaration, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Response or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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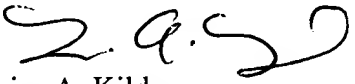

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